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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,393	03/24/2004	Tokunori Kato	119249	3341
25944 7590 03/18/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
WORKU, NEGUSSE				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/807,393

**Applicant(s)**

KATO, TOKUNORI

**Examiner**

NEGUSSIE WORKU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 07 March 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 03/21/06, 03/24/04  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Inventor's Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is a replay to the application filed on 03/24/04, in which, claims 1-16 are pending. Claims 1, 15 and 16 are independent and claim 2-14 are dependent.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 3 the claimed invention lacks patentable utility. Regarding to claim 16, having a process completed program step, but lacks utility, Examiner suggests that claim 16 should be re-written "a computer-readable medium encoded with computer-executable instructions or program".

#### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on 03/03/06, 08/23/04 and 02/24/04, have been reviewed. The submission is in compliance with the provisions of

37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No.10807233. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below:

in this case, it is noted that all independent claims 1, 15 and 16 of the instant application, and all independent claims 1, 29 and 31 of copending application '233' recites a similar limitation of claimed subject matter except that the instant application border than claims 1, 29 and 31 of the copending application '233'.

Claims 1-16 of the instant application '393' are differs from claims of the application '393' in the following way:

Claim 1 of the instant application '393' differs from claim 1 of the copending application No.'233' in that: the difference between the claim 1 of the instant application and the claim 1 of the copending application, No. '233" recites a similar limitation of

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claimed subject matter except that the instant application border than independent claims 1, of the copending application '233'.

9. Regarding claims 2 and 3 the copending application No.'233' read on claim 2 and 3 of the instant application, see claim 15, lines 1-7.

Regarding claims 4, the copending application No.'233' read on claim 2 of the instant application, see claim 10, lines 10-17.

Regarding claims 5, the copending application No.'233' read on claim 5 of the instant application, see claim 1, line 5-10.

Regarding claims 6, the copending application No.'233' read on claim 6 of the instant application, see claim 1, lines 3, and 7-11.

Regarding claims 7 and 8, the copending application No.'233' read on claim 7 of the instant application, see claim 31, lines 1-8

Regarding claims 9, the copending application No.'233' read on claim 9 of the instant application, see claim 28, lines 1-7.

Regarding claims 10, the copending application No.'233' read on claim 10 of the instant application, see claim 14, lines 10-13.

Regarding claims 11, the copending application No.'233' read on claim 11 of the instant application, see claim 14, lines 10-14.

Regarding claims 12 and 13 the copending application No.'233' read on claim 12 of the instant application, see claim 12, lines 1-7.

Regarding claims 14 and 15, the copending application No.'233' read on claim 2 of the instant application, see claim 2, lines 4-7.

Regarding claims 16, the copending application No.'233' read on claim 2 of the instant application, see claim 31, lines 10-25.

In view of this, it is noted that allowing the claims 1-16 of the instant application would result in an unjustified or improper timewise extension of the "right to exclude" granted by patent.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEGUSSIE WORKU whose telephone number is (571)272-7472. The examiner can normally be reached on 9A-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Negussie Worku/

Examiner, Art Unit 2625